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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,616	10/14/2003	Steven I. Carlson	CING-127	5092

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EXAMINER	
EWART, JAMES D	

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/685,616	CARLSON, STEVEN I.	
	Examiner	Art Unit	
	James D. Ewart	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12 and 14-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 14-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Arguments

1. The applicant's arguments regarding prior art rejections, filed June 26, 2006, have been fully considered by the Examiner, but are not deemed persuasive.

2. Regarding the argument that Smith does not teach "obtaining a location information for a called party during establishment of a call to the called party". Smith teaches providing location information of a mobile subscriber station (MS). The mobile subscriber station could be in the process of receiving a call while another mobile station requests the location information. For instance, MS1 requests MS2's location while MS3 is calling MS2 (see 0026). Regarding the argument that Smith does not teach: "placing a call between the calling party and the called party" this argument is moot in view of new grounds of rejection. Regarding the argument that Kwan does not teach converting the location information to voice information. Kwan teaches using a digitizer to convert speech into electrical form and converting the electrical form to speech when an announcement is to be made (0023). The argument that Kwan does not teach "on the fly" location retrieval, this is not a limitation of the claim. The Examiner has simply used the Kwan reference to show a teaching of providing voice information of location. The adaptation of data into voice "on the fly" can be achieved with a voice synthesizer which is old in the art and Stewart teaches the use of a voice synthesizer at the base station (Figure 1, 19) Regarding the argument that Kwan does not disclose "forming a connection between the calling party and the called party and the called party" this argument is moot in view of new grounds of rejection.

3. Regarding the argument that Stewart teaches away from forming a connection between the calling party and the called party because Stewart teaches a method "by which an individual can obtain the location of a user of a portable telephone automatically and without disturbing that user by requiring them to answer a call just for their location" (Column 3, Lines 34-38), the Examiner disagrees and finds that the Applicant's argument is taken out of context. Stewart teaches a mobile station receiving location information from a called mobile station when during call initiation the caller enters a location request code. In Column 6, Lines 19-32, Stewart states: "if no location request code is received within the preset time, the incoming call data..... is transmitted ..... If the user of the portable telephone 28 chooses to answer that call.....can be engaged in an audio conversation in the normal manner". The data transmitted to the called phone includes the location of the caller see figures 3 & 4. In addition, Stewart teaches, in Column 9, Lines 2-5, that if a location request code is entered, meaning the caller wants the location of the called, a bypass switch can be used to ensure "that no locations are transmitted without the user being alerted by the user call alert 34 and then allowing the user to answer the call on the user interface if desired". This means that the called location is provided to the caller and then placing a call between the calling party and the called party as indicated in claim 6. The bypass switch can further be selected to prevent any location information from being transmitted.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-5 & 11-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/685,614. Although the conflicting claims are not identical, they are not patentably distinct from each other because in the copending application 10/685,614 location of a caller is provided to a called party according to settings of the called party, which is the same as the instant application except for the settings of the called party, which is an obvious modification. The instant application also announces the location, which is an obvious modification in light of the well-known process of voice synthesis.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3 and 8 recite the limitation "the intelligent peripheral". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims1,3,6,8,11,16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (U.S. Patent No. 5,606,727) in view of Moton et al. (US Patent Publication no. 2006/0029209).

Referring to claim 1, Stewart teaches a method comprising: obtaining location information for a caller during establishment of a call to a called party (Figure 3, 208); providing the location information to the called party (Figure 3 & Figure 4A, 212) and forming a connection between the called party and calling party (Figure 4A, 230), but does not teach converting the information to voice information and announcing the information. Moton et al. teaches converting the information to voice information and announcing the information (0012). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stewart with the teaching of Moton et al of converting the information to voice information and announcing the information to the called party to

communicate the caller ID information to a recipient in a format which does not have to be seen on a visual display (0011).

Referring to claim 6, Stewart teaches a method comprising: obtaining location information for a called party during establishment of a call to the called party (Column 1, Lines 43-46); providing the location information to the calling party (Column 1, Lines 53-57) and placing a call between the calling party and the called party (Column 9, Lines 1-5), but does not teach converting the information to voice information and announcing the information. Moton et al. teaches converting the information to voice information and announcing the information (0012). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stewart with the teaching of Moton et al. of converting the information to voice information and announcing the information to communicate the caller ID information to a recipient in a format which does not have to be seen on a visual display (0011).

Referring to claim 11, Stewart teaches a network comprising: a switch (Figure 1, 16); at least one network element to track the locations of wireless devices that interact with the network (Figure 2, 40); and at least one Intelligent Peripheral (IP) coupled to a Mobile Service Center that is ***able*** to convert location information for a wireless device obtained from the at least one network element to track locations to a voice announcement (Figure 1, 19), and to interact with the switch to provide the announcement to at least one of a calling wireless device (Figure 3 and Figure 4A, 212) and a called wireless device and at least one network element to establish a call

between the calling wireless device and the called wireless device (Figure 3, 200 and Figure 4A, 230), but does not teach converting the information to voice information and announcing the information. Moton et al. teaches converting the information to voice information and announcing the information (0012). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stewart with the teaching of Moton et al. of converting the information to voice information and announcing the information to communicate the caller ID information to a recipient in a format which does not have to be seen on a visual display (0011).

Referring to claim 16, Stewart teaches a network element comprising: a processor (Figure 1, 20); at least one port (Figure 1, 8); and logic that, when applied to the processor, that is ***able*** to convert location information for a wireless device to a voice announcement (Figure 1, 19), and interacting via the at least one port with a switch (Figure 1, 16) to provide the location information to at least one of a calling wireless device (Figure 3 and Figure 4A, 212) and a called wireless device during the establishment of a call between the calling wireless device and the called wireless device (Figure 3, 200 and Figure 4A, 230), but does not teach converting the information to voice information and announcing the information. Moton et al. teaches converting the information to voice information and announcing the information (0012). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stewart with the teaching of Moton et al. of converting the information to voice information and announcing the information to communicate the caller

ID information to a recipient in a format which does not have to be seen on a visual display (0011).

Referring to claim 18, Stewart teaches a network element comprising: a processor (Figure 1, 20); at least one port (Figure 1, 8); and logic that, when applied to the processor, results in becoming involved in the establishment of a call (Figure 3, 200), obtaining via the at least one port location information for a caller from a network element that provides location information (Figure 3 and Figure 4A, 212), and providing via the at least one port the location information to a network element that delivers the information to a called wireless device (Figure 3 and Figure 4A, 212), but does not teach converting the information to voice information and announcing the information. Moton et al. teaches converting the information to voice information and announcing the information (0012). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stewart with the teaching of Moton et al. of converting the information to voice information and announcing the information to communicate the caller ID information to a recipient in a format which does not have to be seen on a visual display (0011).

Referring to claims 3 and 8, Stewart further teaches: forming a connection between the called party and an intelligent peripheral (IP) (Figure 1, 19); the IP announcing the voice information over the connection between the called party and the IP (Column 6, Lines 36-40).

9. Claims 2,7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart and Moton et al. in further view of Saha et al. (US Patent No. 6,198,935).

Referring to claims 2, 7 and 12, the combination of Stewart and Moton et al. teach providing the location information to an intelligent peripheral (IP); and the IP converting the location information to the voice information, but do not teach obtaining the location information from a Gateway Mobile Location Center (GMLC). Saha et al. teaches obtaining the location information from a Gateway Mobile Location Center (GMLC) (Figure 2). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stewart and Moton et al. with the teaching of Saha et al. of obtaining the location information from a Gateway Mobile Location Center (GMLC) to provide an efficient method of determining the location of a mobile station (Column 2, Lines 39-40)

10. Claims 4,5,9,10,14,15,17,19 & 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart and Moton et al. in further view of Park (US Patent No. 6,434,126).

Referring to claims 4, 9, 14,17,19 and 20, the combination of Stewart and Moton et al. teach converting location information into voice information and announcing the voice information, but they do not teach obtaining name information, converting the name information into voice and announcing the voice information. Park teaches obtaining name information, converting the name information into voice and announcing the voice information (Column 2, Lines 20-31). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stewart and Moton et al. with the

teaching of Park of obtaining name information, converting the name information into voice and announcing the voice information to identify the called/caller without having to view the display (Column 1, Lines 40-46)

Referring to claims 5 and 10, Park further teaches obtaining the name information using Calling Name Address Presentation (CNAP) (Column 1, Lines 32-38).

Referring to claim 15, Park further teaches the at least one network element to obtain name information further comprising: a Line Information Database (LIDB) (Column 12, Line 48). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the combined teaching of Stewart, Moton et al. and Park with additional teaching of Park of at least one network element to obtain name information further comprising: a Line Information Database (LIDB) to provide a function that will return a corresponding name when the SCP provides the caller number (Column 1, 32-38). HLR database is equated with a LIDB

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Barclay et al. U.S. Patent No. 7,085,578 discloses provision of location information to a calling party.

Benco et al. U.S. Patent No. 6,839,022 discloses network support for subscriber access to mobile caller location information.

Dezonno et al. U.S. Patent Publication No. 2004/0203629 discloses intelligent interactive voice response unit.

Gillespie U.S. Patent No. 6,823,048 discloses calling name information caching.

Havinis et al. U.S. Patent No. 6,169,899 discloses system and method for providing historical data for location services.

Maanoja U.S. Patent Publication No. 2004/0185865 discloses quality based location method and system.

Roel-Ng et al. U.S. Patent No. 6,002,936 discloses system and method for informing network of terminal-based positioning method capabilities.

Sheha et al. U.S. Patent Publication No. 2003/0016804 discloses position determination system.

Urban et al. U.S. Patent Publication No. 2004/0209605 discloses caller ID messaging.

Zhu et al. U.S. Patent Publication No. 2004/0203613 discloses mobile terminal.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James D. Ewart whose telephone number is (571) 272-7864. The examiner can normally be reached on M-F 7am - 4pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571)272-7872. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2600.

James Ewart
October 5, 2006

WILLIAM TROST
SUPERVISORY PATENT EXAMINER
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